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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,049	01/08/2001	Harold S. Bernstein	UCSF-020/02US	6383

7590

05/21/2002

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EXAMINER

DAVIS, KATHARINE F

ART UNIT PAPER NUMBER

1636

DATE MAILED: 05/21/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,049

Applicant(s)

BERNSTEIN ET AL.

Examiner

Katharine F. Davis

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to an hCdc5 polypeptide, classified in Class 530, subclass 350.
- II. Claims 2 and 3, drawn to an antibody reactive with the hCdc5 polypeptide, classified in Class 530, subclass 387.1.
- III. Claims 4-14, 64 and 65, drawn to a method for treating a cell cycle defect in a patient by administering a protein (hCdc5), classified in Class 514, subclass 2.
- IV. Claims 15-24, 26-35, 62 and 63, drawn to a method for treating a cell cycle defect in a patient by administering an antagonist of hCdc5, classified in Class 530, subclass 387.1 or Class 536, subclass 24.5, for example.
- V. Claim 25, drawn to a method of treating a patient having a hyperproliferative disease by administering to the patient a nucleic acid encoding an hCdc5 polypeptide, classified in Class 514, subclass 44.
- VI. Claims 36-55, drawn to a method for identifying an inhibitor or enhancer compound of hCdc5 binding to a DNA binding site, classified in Class 435, subclass 6.
- VII. Claims 56-61, drawn to a nucleic acid, vector, a method for expressing a protein of interest and a method for detecting a hCdc5 protein in a cell, classified in Class 435, subclass 69.1; 320.1; 456 and Class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and VII are related to Inventions III, IV and VI, respectively, as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products (nucleic acids, polypeptides and antibodies) of Inventions I, II and VII can be used in many different assays and/or compositions other than those methods of Inventions III, IV and VI.

Additionally, the Inventions drawn to products and the Inventions drawn to methods are separate and distinct as described below.

Inventions I, II and VII are all claimed by product claims. Each of the three products (nucleic acids, polypeptides and antibodies) are patentably distinct products; each having different chemical and physical properties. Each of these products also has separate uses.

Inventions III, IV, V and VI are all claimed by methods claims. Each of these methods is patentably distinct. Each method involves unrelated starting materials, distinct procedural steps directed toward unrelated outcomes and each method can be used in separate applications.

Furthermore, Inventions I-VII are separate and distinct as they require materially different searches, a search for one product or one method will not necessarily encompass all of the claimed products and methods. A through search of the art for all of the claimed groups would require additional terms and hits to review thus constituting a burdensome search for the examiner.

Because these inventions are distinct for all of the reasons discussed above and have acquired a separate status in the art because of their recognized divergent subject matter, different classification and separate search requirements, restriction for examination purposes as indicated is proper.


A telephone call was made to Catherine Polizzi on April 12, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195 with direct desktop RightFax (703) 746-5199. The examiner can normally be reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel can be reached on (703) 305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry of a general nature or any inquiry concerning the formalities of this application should be directed to Patent Analyst Tracey Johnson whose telephone number is (703) 305-2982.

Katharine F. Davis
May 20, 2002


REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
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